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10/598,711	01/23/2007	Diane Joyce Burt	102792-618 (11416P1 US)	9233
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NORRIS, MCLAUGHLIN & MARCUS			EXAMINER	
875 THIRD AVE			DOUYON, LORNA M	
18TH FLOOR				
NEW YORK, NY 10022			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/598,711

Applicant(s)

BURT ET AL.

Examiner

Lorna M. Douyon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 9/8/06; 11/3/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Claim Rejections - 35 USC § 112

1. Claims 16, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims **16, 18 and 19** recite a broad recitation of limitation/range, followed by narrower limitation/range (i.e. "preferably...").

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11, 13-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Antonelli et al. (US Patent No. 3,632,516), hereinafter "Antonelli".

Antonelli teaches a package for preparing and dispensing heated foam, which comprises a container having an outlet and a valve adapted to control the dispensing of foam from the outlet and having separately contained therein (a) hydrogen peroxide oxidant and (b) a reductant composition comprising a soap solution containing: (1) potassium thiosulfate and a catalytic amount of sodium tungstate, or (2) a mixture of potassium thiosulfate and potassium sulfite and a catalytic amount of sodium tungstate; components (a) and (b) being present in amounts which when co-dispensed produce a heat generating redox reaction which imparts a warming effect upon the dispensed foam (see col. 1, lines 12-27). The calculated minimum concentration of reactants required to heat the dispensed lather to a 30°C increase in temperature is 5.41 wt% K₂SO₃ and 4.64 wt% hydrogen peroxide (see col. 2, lines 33-38 and Table 1). For shaving foam, the composition usually contains about four to about thirty percent by weight of foam producing agents like soluble anionic soaps (see col. 5, lines 34-43). In one example, Antonelli teaches the preparation of a soap formulation in two parts, Part A which comprises 4.5 wt% polyoxyethylene sorbitan monostearate (a nonionic surfactant), 1 wt% lauric acid and 7.0 wt% stearic acid, and Part B which comprises reductant, potassium hydroxide (base) and triethanolamine (also a base) and water, and wherein Part A is added to Part B (see col. 6, lines 25-73). In Example 3, K₂S₂O₃

(4.0 wt percent) in soap solution was reacted with H_2O_2 (8.2 wt percent) in the presence of $\text{Na}_2\text{WO}_4 \cdot 2\text{H}_2\text{O}$ (0.25 wt percent) with a peak temperature increase of 31°C (see col. 7, line 68 to col. 8, line 2). Other changes in temperature are shown in the Table under col. 9, such as 47°C . The composition is useful for preparing warm aqueous foam or lather for such applications as conditioning areas of a person to be shaved, and washing the skin or hair (see col. 10, lines 10-14). Antonelli teaches the limitations of the instant claims. Hence, Antonelli anticipates the claims.

4. Claims 1-12, 14-16, 18-19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Prussin et al. (US Patent No. 3,966,090), hereinafter "Prussin".

Prussin teaches a package adapted for the dispensing of an antiseptic iodine-containing composition therefrom which comprises a pressure-tight container with means to maintain two ingredients therein isolated from each other, the first of said ingredients comprising about 2 - 50 weight percent of an alkali metal iodide (reducing agent) selected from the group consisting of potassium iodide and sodium iodide and the second of said ingredients comprising about 2 - 30 weight percent hydrogen peroxide, a liquified gaseous propellant in at least one of said ingredients and valve means communicating with each of said ingredients adapted to mix effective portions of each of said ingredients to dispense from said package a heated composition containing free iodine (see claim 1). The composition also contains, in the first ingredient, about one percent or less by weight of a catalyst selected from the group consisting of sodium molybdate, sodium titanate, sodium vanadate, and sodium

tungstate (see claim 5). In Example IV, Prussin teaches a package wherein the pressure-tight container comprises Composition **A** comprising 1.9 wt% polyoxyethylene lauryl ether (a nonionic surfactant), 14% Hydrogen Peroxide (35% strength), wherein by calculation, hydrogen peroxide is 4.9 wt%, and water to balance the amounts to 75 parts by weight for Composition **A** and 2.9% sodium iodide with the balance water to equal 25 parts by weight for Composition **B**. Formulations of the present invention may also be devised which take advantage of the fact that hydrogen ions are involved in the oxidation of iodide ion to significantly increase the amounts of free iodine while simultaneously warming the end product. Such formulations incorporate between about 1 to 25 weight percent thermogenic agent selected from the group consisting of potassium, sodium and ammonium salts of thiosulfuric, thiocyanic, thioglycollic and sulfurous acids. The agents are preferably used in the presence of about one percent or less by weight of a catalyst selected from the group consisting of molybdate, titanate, vanadate, and tungstate salts. Preferably sodium salts are utilized because of ready commercial availability (see col. 5, lines 29-53). A particular advantage of the iodine-containing compositions dispensed from the package is that controllable heat may be evolved, the compositions may thus be dispensed in a warmed state, and this improves the efficacy of cleaning and antiseptic action of such composition (see col. 2, lines 13-18). The composition is used for cleaning the hands of a surgeon prior to operative procedures, in treatment of acne and dandruff and in general antiseptic uses (see col. 1, lines 14-18). Washing the skin with water after application of the composition results in a total absence of a brown stain (see col. 4, lines 58-60). Even though Prussin does not

explicitly disclose a temperature elevation of at least 5°C, or 20°C, or 30°C, it would be inherent for the composition of Prussin to exhibit the same property because same ingredients and proportions have been utilized. Hence, Prussin anticipates the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prussin as applied to the above claims.

Prussin teaches the features as described above. Prussin, however, fails to specifically disclose a reducing agent in the range of 4 to 7 wt%.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the prima facie case of obviousness. See *In re Boesch*, 627 F.2d 272,276,205 USPQ 215,219 (CCPA 1980). See also *In re Woodruff*

919 F.2d 1575, 1578,16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454,456,105 USPQ 233,235 (CCPA 1955).

In addition, a *prima facie* case of obviousness exists because the claimed ranges "overlap or lie inside ranges disclosed by the prior art", see *In re Wertheim*, 541 F.2d 257,191 USPQ 90 (CCPA 1976; *In re Woodruff*, 919 F.2d 1575,16USPQ2d 1934 (Fed. Cir. 1990). See MFEP 2131.03 and MPEP 2144.05I.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Antonelli as applied to the above claims, and further in view of Prussin.

Antonelli teaches the features as described above. Antonelli, however, fails to disclose sodium thiosulfate.

Prussin, an analogous art, teaches the equivalency of potassium thiosulfate and sodium thiosulfate (see col. 5, lines 43-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the potassium thiosulfate of Antonelli with sodium thiosulfate because the substitution of art recognized equivalents as shown by Prussin is within the level of ordinary skill in the art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered cumulative to or less material than those discussed above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/
Primary Examiner, Art Unit 1796

